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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,918	10/30/2003	Gali Shahar	1900/25	5651

7590 04/14/2008

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EXAMINER	
DOUGHERTY, PAUL J	
ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
04/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/695,918	SHAHAR, GALI	
	Examiner	Art Unit	
	PAUL J. DOUGHERTY	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 May 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 101, 102, 103, 104. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because they are illegible. This applies only to Figure 1 in which the text is blurred and illegible. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

3. Claim 1 is objected to because of the following informalities: The first line of Claim 1 recites "playing as interactive". The claim should read "playing an interactive". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15-16, and 31-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the limitation "said code". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendkos (US Patent No. 5,983,196).

Regarding Claims 1 and 17: Wendkos discloses a system and method for playing as interactive game at an Internet Website of at least one entity, the system comprising at least one server 110 for communicating with a plurality of user clients 140 being operated by a plurality of users, said at least one server being designed and configured for:

(a) establishing an Internet connection (network may be the Internet; Col 2, Line 24) with at least one user client (2820; Figure 28; Col 16, Line 63-64);

(b) receiving from at least one said user client of said plurality of user clients a completed first offline portion of said game (users can play a game off-line, based on content stored on a CD-ROM, and complete a portion of the game by making a choice that achieves a certain threshold level; Col 16, Line58-66), via said Internet connection, said first portion of said game being distributed to a user of said plurality of users only upon an off-line medium (first portion of game is distributed via CD ROM, floppy disk, network downloaded program or other memory medium; Col 17, Line 3-6);

(c) thereafter, presenting said user client with the remaining portions of the game (award processing and further program interactive execution; Col 16, Line 63-67), via said Internet connection (the user is connected to the interactive platform over the network where an award processing protocol will be executed and the player may be awarded; Col 16, Line 63 – Col 17, Line 2), so as to allow said user to play (in light of applicant's use of the term "play" in Para. 67 and Para. 80-81, the examiner notes that

the term "play" is interpreted to mean user interaction with any portion of the game, including startup/initiation of the game, traditional interactive application-specific game play, and extending to game ending and reward processing) said remaining portions of the game online using said user client, via said Internet connection (remaining portions of the game including awards processing and continued program interactive execution are completed while the user is connected over the network; Col 16, Line 63 - Col 17, Line 2); and

(d) determining whether said user client has won or completed the game (award processing based on game score or threshold; Col 16, Line 60-63).

Wendkos does not expressly disclose the off-line medium further bearing an Internet address of the entity. However, Wendkos discloses an embodiment involving a coupon which bears the telephone number for contacting the system to complete an online portion of a telephone embodiment of the game (Col 2, Line 35-38; Col 3, Line 52-57). Wendkos additionally discloses a participant database which in the case of the phone embodiment stores the telephone number of the participant and in the case of the computer network environment embodiment stores the network address of the user (Col. 7 Line 4-7). The use of Internet addresses to connect to an on-line game was also notoriously well known in the art.

Since Wendkos demonstrates the need to provide information to a user to enable connecting to an online system (telephone system) and a solution for doing so (displaying the telephone number on the offline medium) and further discloses that network addresses are used for identification purposes in a computer network it would

have been obvious to one of ordinary skill in the art at the time the invention was made to modify the off-line medium of the computer network embodiment of Wendkos to bear an Internet address of the entity in order to achieve the predictable result of enabling a player to access an on-line portion of a game in the computer-network embodiment.

9. Regarding Claims 2 and 18: Wendkos discloses if said user client has won or completed the game, said server awards a user of said user client a prize (Col 16, Line 60-63).

10. Regarding Claims 3, 5, 6, 19, 21, 22: Wendkos discloses that the off-line medium is selected from the group consisting of tangible medium (CD-ROM) and electronic medium (network downloaded program; Col 17, Line 3-6). It also noted that all of the alternate claimed tangible (a computer diskette, a magneto- optical cartridge, a ZIP™ disc, a JAZZ™ disc, an advertising flyer, a preprinted coupon, a coupon printed at a point of sale, at least a portion of a package of a durable good, at least a portion of a receipt, a game card and a token) and electronic media (a portion of the body of an e-mail message, at least a portion of an e-mail attachment, a hypertext link, a JAVA™ script, an executable file, and at least a portion of a facsimile transmission) were well known at the time the invention was made for delivering gaming content and it would have been obvious to one of ordinary skill to substitute any of the alternate media for the disclosed media to achieve the predictable result of enabling off-line play of a game.

11. Regarding Claims 4 and 20: Wendkos does not expressly disclose the functionality of at least one server being provided by a combination of two or more

servers. However, it was well know in the art to provide multiple servers duplicating or dividing functionality to provide scalability of the network and it would have therefor been obvious to one of ordinary skill in the art at the time the invention was made to provide additional servers to Wendkos to support an increase in users.

12. Regarding Claims 7 and 23: Wendkos discloses the off-line medium being distributed through a distribution channel such as together with a product for sale (Col 2, Line 31-35). Additionally, it is noted that the alternate claimed distribution methods (direct mailing, hand delivery to residences, hand delivery to places of business, distribution to employees in a workplace, distribution to students in a school, distribution with a periodical publication, distribution from distribution points in public places, e-mail and facsimile transmission) were all well known methods for distributing promotional or commercial materials at the time the invention was made and it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute any of these claimed distribution methods for the disclosed distribution method to achieve the predictable result of distributing to a wider audience.

13. Regarding Claims 8 and 24: Wendkos discloses at least one server being further designed and configured for soliciting and receiving user specific information from said at least one user operating said user client (2530; Figure 25B).

14. Regarding Claims 9 and 25: Wendkos discloses that the server is further designed and configured for facilitating redemption of said prize (Col 16, Line 60-63; Figure 21).

15. Regarding Claims 10 and 26: Wendkos discloses that the server is further designed and configured for displaying one of a plurality of promotional messages (Figure 10).

16. Regarding Claims 11-13 and 27-29: Wendkos discloses that the game may be a video game (interactive game such as football; Col 11, Line 61-64) but does not expressly disclose that it may be chess, backgammon, a card game (poker game, blackjack, rummy, gin, solitaire, cribbage, casino, whist, euchre and acey-deucy), a dice game (craps, casino craps, chuck a luck and over/under), checkers, Chinese checkers, go, MONOPOLY™, SORRY™, a video game, a virtual reality game, DUNGEONS AND DRAGONS™, a maze, lotto, bingo, keno, a race, a contest, a quiz, or a test. However, all of the claimed alternate games were well known in the gaming art and it was also well known to take a known game and incorporate it as a bonus to another game or as a part of a promotion therefor it would have been obvious to substitute the interactive game disclosed by Wendkos with any of the known alternate games to achieve the predictable result of providing additional incentive to take part in the promotion.

17. Regarding Claims 14 and 30: Wendkos discloses at least two entities acting in concert (internet service provide must act in concert with the host website; Figure 1).

18. Regarding Claims 15 and 31: Wendkos discloses that the code is unique in that it appears on only one of said off-line medium distributed to a user of said plurality of users (Col 2, Line 35-38).

19. Regarding Claims 16 and 32: Wendkos discloses that each of said unique codes expires after a single use, such that each user of said plurality of users may play the game only one time with each of said off-line medium (1930, Figure 19).

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Busch et al. discloses a game that is played partly off-line and partly on-line where the interactive game play occurs via an internet website and also discloses the use of a code displayed on the off-line game medium which is used to initiate game play. The patent to Hawkins et al. discloses adapting numerous games such as Monopoly, poker and chess to online computer games. Peppel discloses an electronic trading card game that is played partially off-line and partially on-line.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL J. DOUGHERTY whose telephone number is (571)270-1610. The examiner can normally be reached on Mon-Thurs 7am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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